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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,390	12/05/2003	Michael W. Brennan	40212.8002.US01	8127

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EXAMINER	
DOTE, JANIS L	

ART UNIT	PAPER NUMBER
1756	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/729,390	BRENNAN, MICHAEL W.	
	Examiner	Art Unit	
	Janis L. Dote	1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 May 2004*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) *5,47 and 48* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☒ Claim(s) *5,47 and 48* is/are objected to.

8)☒ Claim(s) *1-4 and 6-46* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Instant claims 5, 47, and 48 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to the other claims in the alternative only. Claim 5 depends [improperly] on claims 2 and 3. Claim 47 depends [improperly] on claims 1 and 46. Claim 48 depends [improperly] on claims 15 and 46. See MPEP § 608.01(n). Accordingly, instant claims 5, 47, and 48 have not been further treated on the merits. In particular, claims 5, 47, and 48 are not part of the restriction requirement set forth infra.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4 and 6-14, drawn to formulations of nonmagnetic toners, classified in class 430, subclass 430/108.8.

II. Claims 15-45, drawn to non-magnetic toning systems, classified in class 399, subclass 119.

III. Claim 46, drawn to method of printing, classified in class 430, subclass 120.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process, such as a process comprising the steps of placing the toner of Invention I into a can having a fine wire screen closing its mouth, and developing an electrostatic latent image by hand sprinkling the toner of Invention I onto the image-wise exposed latent electrostatic image-bearing member from the can that comprises the toner. The toner in Invention I can also be used in cascade developing an electrostatic latent image on a sheet to form a toner image with a developer comprising the toner of Invention I and a carrier. In cascade developing, the developer is placed on a tray and the latent image is developed by flowing or cascading the developer over the electrostatic latent image. Both processes do not require placing the toner in an interchangeable non-magnetic toning system (NMTS), which

then replaces a magnetic toner system of a printing system with the NMTS, as recited in Group III.

Inventions III and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process, such as a process comprising the step of replacing the non-magnetic toning system in a non-magnetic toner printing apparatus with the non-magnetic toning system of Invention II.

Invention I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination has separate utility such as in the process of cascading developing or the process of hand developing as discussed above. See MPEP § 806.05(d). Applicant is advised that the non-magnetic toning system in

Invention II is an apparatus, which is defined by its structure, not by the manner in which it is used or the materials it works upon. The claims in Invention II recite "using the toner formulation of Invention I." The recited toner does not provide any structural limitations to the apparatus, but is a material acted upon by the apparatus. "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." See MPEP 2115. Also see Ex parte Masham, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987). Thus, the recitation of using the particular toner of Invention I in the apparatus claims of Invention II does not provide any patentable weight to the apparatus of Invention II. Accordingly, the apparatus of Invention II is patentably distinct from the toner of Invention I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to

Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Mr. Nam Nguyen, can be reached on (571) 272-1342. The central fax phone number is (571) 273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JANIS L. DOTE
PRIMARY EXAMINER
GROUP ~~1500~~ 1700

JLD
Mar. 16, 2006